



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,477	05/23/2001	Victor I. Sheymov	741946-21	8949

22204 7590 09/30/2004

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,477

Applicant(s)

SHEYMOV

Examiner

David Y Jung

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/01, 2/02, 7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed 5/01, 2/02, 7/04) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

While there is evidence that Applicant has tried to send such copies, the Office does not have the copies in possession. Missing are:

From IDS of May 2001:

Hynninen "Experiences in Mobile Phone Fraud"

From IDS of February 2002:

WO 00/13339 from Qualcomm

From IDS of July 2004:

Pescatore "Secure Use of the World Wide Web."

Claims Presented

Claims 1-23 are presented.

Claims 1, 2, 4, 6-13, 15, 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US Patent 5579376, cited by Applicant).

Claims 3, 5, 14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US Patent 5579376, cited by Applicant) and "Cloning",

Art Unit: 2134

(www.isaacc.cs.berkeley.edu/isaac/gsm-faq.html, a reprint of 1998 article, cited by Applicant).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-13, 15, 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US Patent 5579376, cited by Applicant).

In regard to claim 1, Kennedy teaches "A communications system comprising: at least one mobile ... identifier that identifies a communications device; and at least one updateable identifier, wherein the updateable identifier is used in communications with the communications device (column 1, lines 64-33, i.e. the mobile identification number and the various ways that this "MIN" is used to defeat roamer fraud)."

These passages of Kennedy are not explicit regarding "unit" identifier.

Nevertheless, it was well known in the art to treat a mobile device as a single unit for the motivations of easier manufacturing and of easier identification.

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to modify Kennedy so as to teach the claimed invention for the motivation stated in the previous sentences.

Regarding claims 2 (correlation of identifiers, etc.), such features are well known in the art for the motivation of security. For example, note the matching of network planning area number (NPA) and the pseudo NXX number of Kennedy in the cited passages. Regarding claim 4 (updating of number, etc.), such features are well known in the art for the motivation of effective security (by changing and identifiers, the identification data becomes more secure and more easily be identified). Regarding claims 6-11 (various systems of communications, etc.), such features are well known in the art for the motivations of wide applicability and of security.

In regard to claim 12, Kennedy teaches "A communications method comprising: receiving at least one mobile ... identifier that identifies a communications device; and determining at least one updateable identifier, wherein the updateable identifier is used in communications with the communications device (column 1, lines 64-33, i.e. the mobile identification number and the various ways that this "MIN" is used to defeat roamer fraud)."

These passages of Kennedy are not explicit regarding "unit" identifier. Nevertheless, it was well known in the art to treat a mobile device as a single unit for the motivations of easier manufacturing and of easier identification.

Art Unit: 2134

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to modify Kennedy so as to teach the claimed invention for the motivation stated in the previous sentences.

Regarding claims 13 (correlation of identifiers, etc.), such features are well known in the art for the motivation of security. For example, note the matching of network planning area number (NPA) and the pseudo NXX number of Kennedy in the cited passages. Regarding claim 15 (updating of number, etc.), such features are well known in the art for the motivation of effective security (by changing and identifiers, the identification data becomes more secure and more easily be identified). Regarding claims 17-22 (various systems of communications, etc.), such features are well known in the art for the motivations of wide applicability and of security.

In regard to claim 23, Kennedy teaches "An information storage media comprising: information that replaces at least one mobile ... identifier that identifies a communications device with at least one updateable identifier, wherein the updateable identifier is used in communications with the communications device (column 1, lines 64-33, i.e. the mobile identification number and the various ways that this "MIN" is used to defeat roamer fraud)."

These passages of Kennedy are not explicit regarding "unit" identifier. Nevertheless, it was well known in the art to treat a mobile device as a single unit for the motivations of easier manufacturing and of easier identification.

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to modify Kennedy so as to teach the claimed invention for the motivation stated in the previous sentences.

Claims 3, 5, 14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US Patent 5579376, cited by Applicant) and "Cloning", (www.isaacc.cs.berkeley.edu/isaac/gsm-faq.html), a reprint of 1998 article, cited by Applicant).

Kennedy teaches as noted in the previous sections.

Regarding claim 3, Kennedy does not teach detecting "unauthorized" communication, etc.. Kennedy does not teach such particular authentication.

Cloning teaches such authentication (Background section, i.e. the discussion on authentication and cryptography), and hence teaches such detecting of "unauthorized" communication.

Furthermore, it is well known in the art to detect unauthorized communication for the motivation of security.

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to combine Kennedy and Cloning so as to teach the claimed invention for the motivation stated in the previous sentences.

Art Unit: 2134

Regarding claim 5, Kennedy does not teach "cryptography", etc. Kennedy does not teach such particular cryptography.

Cloning teaches such authentication (Background section, i.e. the discussion on authentication and cryptography), and hence teaches such "cryptography." At least the communication between the service provider and the user is encrypted.

Furthermore, it is well known in the art to have cryptography for the motivation of security.

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to combine Kennedy and Cloning so as to teach the claimed invention for the motivation stated in the previous sentences.

Regarding claim 14, Kennedy does not teach detecting "unauthorized" communication, etc.. Kennedy does not teach such particular authentication.

Cloning teaches such authentication (Background section, i.e. the discussion on authentication and cryptography), and hence teaches such detecting of "unauthorized" communication.

Furthermore, it is well known in the art to detect unauthorized communication for the motivation of security.

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to combine Kennedy and Cloning so as to teach the claimed invention for the motivation stated in the previous sentences.

Art Unit: 2134

Regarding claim 16, Kennedy does not teach "cryptography", etc. Kennedy does not teach such particular cryptography.

Cloning teaches such authentication (Background section, i.e. the discussion on authentication and cryptography), and hence teaches such "cryptography." At least the communication between the service provider and the user is encrypted.

Furthermore, it is well known in the art to have cryptography for the motivation of security.

It would have been obvious to those of ordinary skill in the art, at the time of the claimed invention to combine Kennedy and Cloning so as to teach the claimed invention for the motivation stated in the previous sentences.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

Art Unit: 2134

(703) 746-7239, (for formal communications intended for entry)

Or:

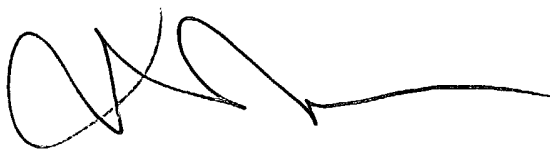
(703) 746-5606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to David Jung whose telephone number is (703) 308-5262
or Greg Morse whose telephone number is (703) 308-4789.

David Jung

Patent Examiner

A handwritten signature in black ink, consisting of a large, stylized 'D' followed by a series of loops and a long horizontal stroke extending to the right.

Application/Control Number: 09/862,477

Page 10

Art Unit: 2134

9/28/04

A handwritten signature in black ink, consisting of a series of connected loops and a final upward stroke.